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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,087	01/30/2002	Benjamin C. Rivera	JPS 756.712	2441
152	7590	12/19/2005	EXAMINER	
CHERNOFF, VILHAUER, MCCLUNG & STENZEL 1600 ODS TOWER 601 SW SECOND AVENUE PORTLAND, OR 97204-3157			SHAKERI, HADI	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/066,087	RIVERA, BENJAMIN C.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hadi Shakeri	3723	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-52,55,57,59-61,67 and 69-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-52,55,57,59-61,67 and 69-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>101705</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the independent spring (claim 87) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 70, 75-77, 72-74, 78-87, 88, 89-93, and 94-98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claims 70 and 76, what is being claimed by the "elongated edge".

Specification as originally filed defines edges (18) and (22), but in claim 70 it appears the flange is defined as the edge and in claim 76, the integral sides of the flange (the outer side and the inner side joined with the floor), and the outer edge of the flange is defined as the elongated edge of the floor, rendering the scope unascertainable, since it is unclear what structure is being claimed by the term "elongated edge".

Regarding claims 75 and 77, the narrative and intended use language as recited, that the flange is free of additional structure forming a second channel, renders the scope of the claims unascertainable, because the frame member for a holding tool, as defined by the original specification, is defined to be joined by another structure, e.g. the scale (36), to define a pocket, otherwise it would not form a "frame member for folding tool". It is noted that "integral" as defined by the specification and its broad definition "formed as a unit with another part", which renders the claims indefinite.

Claim 72 recites the limitation "said cut" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 78-87, the recitation that "a first side scale, not integral with said frame member, arranged...tool pocket..." creates ambiguity. The limitation is added in reading over prior art of record, and as such does not have antecedent basis in the specification as originally filed. The narrow definition attempted to attribute to the term "integral" cannot be supported in the specification as originally filed. The term integral is only used in reference to the flange and the leaf spring, meeting the broad definition of integral as indicated above, i.e., "formed as a unit with another part", which would render the language as recited in claim 78 (and claim 79) indefinite, since if the scale is not integral with the frame member, cannot be attached thereto

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and therefor cannot form a pocket. It is also noted with regards to claims 81, 85, a method of forming is claimed, which renders the scope unascertainable in an article claim.

With regards to claims 88, 89 and 94, the intended use language, as indicated above renders the claims indefinite, since the flange in the instant application, serves as a floor for a pocket formed as a unit with other structure (scales).

### ***Claim Rejections - 35 USC § 102***

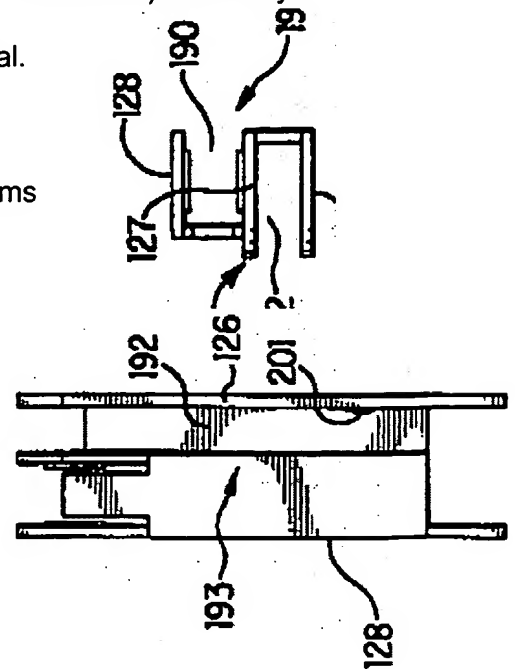
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 49, 52, 61, 67, 69-77, 88, 89, 94, 95 and 99 (as best understood) are finally rejected under 35 U.S.C. 102(e) as being anticipated by Taggart et al. (6,341,423).

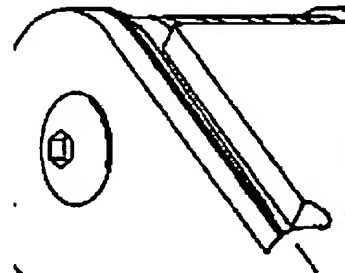
Taggart et al. discloses all of the limitations of the above claims (as best understood), i.e., a handle for a folding tool comprising an elongate channel-shaped frame member having an outer margin with a first elongate side and first and second spaced- apart elongate channel walls integrally joined together by a channel floor to define a channel (192), said frame member further including an integral first external flange (defining the floor in channel 190) extending outwardly from at least a portion of said



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first channel wall in a first direction away from said channel, said first external flange including an integral first leaf spring, said first leaf spring forming a portion of said first elongate side of said outer margin.

Regarding claim 99, Taggart et al. meets the limitation, i.e., wherein the portion of the flange that forms the spring is separated from an adjacent portion of the channel wall by a cut in the channel wall (at the upper edge).



### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 50, 51, 55, 57, 59, 60, and 100, (as best understood) are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Taggart et al.

Taggart et al. meets all the limitations of claim 50, except for an integral second spring opposite the first on the flange (floor of 190). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include another integral spring on the floor, in adapting the tool for a particular tool bit and application, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Taggart et al. meets all the limitations of claims 51, except for the location of the spring. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the floor accommodating the spring shorter, depending on a particular tool bit or

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intended use, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikes*, 86 USPQ 70.

Taggart et al. meets all the limitations of claim 55-60, and 100, except for a second flange extending in an opposite direction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the tool by including a third channel with wall (128) as the common wall, in adapting the tool to accommodate more tool bit and applications, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8., and with regards to another spring, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an integral spring on the floor defining the channel (192), in adapting the tool for a particular tool bit and application, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### **Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

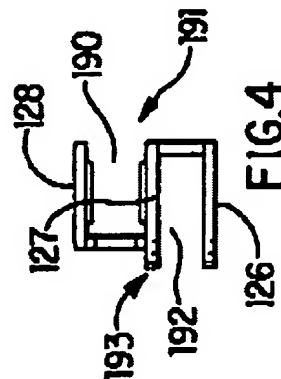
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Response to Arguments***

9. Applicant's arguments filed 09/23/05 have been fully considered but they are not persuasive. The argument that the floors in the channel (190 and 192) of Taggart et al. does not meet the limitation of "external" flange relative to the channel is not persuasive, since the flange defined by the floor of channel (19) is external to the channel (192). The argument regarding a "single" channel is not persuasive, since the flange (floor of 190) is extending perpendicular to the "single channel" (192), because the pair of sidewalls (126, 127) defines a "single channel" in the frame member. Note that the flange as described and defined in the instant application is formed to be joined by another structure, e.g., the scales to form another pocket, i.e., another channel, and to argue that "a frame member for a folding tool" as defined by the specification for the embodiment elected (e.g., Fig. 16) only has one channel renders the scope of the claims unascertainable, at least for omitting essential structure, as required MPEP § 2172.01. The argument that Taggart et al. creates the spring by two cuts, does not apply, e.g., to claim 99. The claim recites for the portion of the flange that forms the spring to be separated from the adjacent sidewall by an elongated cut substantially in the sidewall, which met by Taggart et al.



### ***Conclusion***

10. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Kershaw et al., Hallvarson, and Slayton are cited to show related inventions.

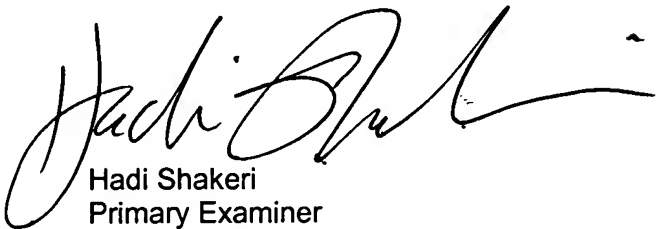


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is (571) 272-4495. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hadi Shakeri', with a long horizontal flourish extending to the right.

Hadi Shakeri  
Primary Examiner  
Art Unit 3723  
December 12, 2005